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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,820	04/06/2001	Reem Safadi	GEN-150	6453
20480	7590	05/10/2005	EXAMINER	
STEVEN L. NICHOLS RADER, FISHMAN & GRAVER PLLC 10653 S. RIVER FRONT PARKWAY SUITE 150 SOUTH JORDAN, UT 84095			REAGAN, JAMES A	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,820

Applicant(s)

SAFADI ET AL.

Examiner

James A. Reagan

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 27-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 27-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This action is in response to the amendment filed on 31 January 2005.
2. Claims 27 and 33 have been amended.
3. Claims 39-45 have been added.
4. Claims 1-16 and 27-45 have been examined.
5. The rejections of claims 1-16 and 27-38 remain the same.
6. The rejections of claims 39-45 are new.

RESPONSE TO ARGUMENTS

7. Applicant's arguments received on have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.

With regard to the limitations of claims 1, 5, 27, and 33, Applicant argues that Stefik does not teach or suggest the claimed distribution means that registers said at least one playback means to trace said content distributed to said at least one playback means, authenticates said at least one playback means, requests an initiation of, secure communications (with the playback means), and transfers said content from said distribution means to said at least one playback

means. However, it appears as if the Applicant is reading limitations into the claims from the specification. Consequently, the points argued are not recited in the claims themselves. For that reason, a solid argument in their contemplation cannot be established. Subsequent amendments to the claim language that would include the positions presented by the Applicant's arguments would provoke the Examiner to address the claims individually and as a whole, in light of the remaining limitations as well as the specification. Until such amendments are rendered, the arguments are disregarded and will not be countered.

In summary, the Examiner has taken the broadest and most reasonable interpretation of the claim limitations as written, in light of the specification. Although the specification may contain recitations of intended use, alternative points of view and subjective interpretative differences between the prior art of record and the present invention as premeditated, it is the claims themselves that are given patentable weight only inasmuch as they are constructed. Because the claimed invention has been painted with the broad stroke of petitioning for limitations that encompasses more than is asserted in the Applicant's claims, the prior art of record continues to fully disclose the Applicant's inventions *as claimed*. In this case, Stefik clearly discloses a repository for providing secure digital content to a playback device. See at least the abstract as well as other relevant text.

In addition, Applicant argues that the Examiner has failed to specifically point out how the references disclose or teach each element and limitation recited in the claims. It should be noted that the Examiner is not required to map each limitation to a cited passage within the prior art of reference, as is suggested by the Applicant, nor is it the Examiner's responsibility to translate the technology, techniques, and/or methods of the prior art of record, since it is the assumption of the Examiner that the Applicant and the Applicant's representatives are those of at least ordinary skill in the art. Since the Examiner assumes that the Patents used in making the rejections with regard to and in light of the instant claims have complied with the enablement standards at set for the by the United States Patent and Trademark Office, the Examiner correctly deduces that one

of common skill would be able to read, understand, and manufacture the innovation as disclosed by the inventors. Subsequently, since the Applicants and their representatives are considered to be at least fundamentally schooled in the arts of the instant invention, it is also correct for the Examiner to infer that the same are capable of comprehending and appreciating the prior art as disclosed by the inventors and accredited by the USPTO. Ergo, the passages cited by the Examiner are a courtesy meant not only to lay a foundation of rejection of the claim limitations, but also to introduce the prior art of record as a benchmark of knowledge currently employed by artisans of the past and present, and also for establishing a pathway for continued prosecution. It is incumbent upon the Applicant and the Applicant's representative, then, to evaluate the prior art of record, point out misconceptions or other inaccuracies made by the Examiner, assert limitations that have not been properly addressed or that are novel, and, if deemed necessary, amend the claims to overcome the prior art of record, each and all in pursuit of an allowance.

With regard to claims 7, 14, 30, 32, 36, and 38, the common knowledge declared to be well-known in the art is hereby taken to be admitted prior art because the Applicant either failed to traverse the Examiner's assertion of Official Notice or failed to traverse the Examiner's assertion of Official Notice adequately. To adequately traverse the examiner's assertion of Official Notice, the Applicant must specifically point out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. A general allegation that the claims define a patentable invention without any reference to the Examiner's assertion of Official Notice would be inadequate. Support for the Applicant's assertion of should be included.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-6, 8-13, 15, 16, 27-29, 31, 33-35, 37, 39, and 42-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Stefik et al. (US 5,629,980 A).

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claims 1-6, 8-13, 15, 27-29, 31, 33-35, 37, 39, and 42-45:

Stefik discloses assigning usage permission rights to digital works to include encryption techniques, identification and authorization certificates for data repositories and playback devices, transfer and storage of the digital work from a repository to the playback device, copyright protocols, and registration transactions, as well as a deletion step for digital works.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 7, 14, 30, 32, 36, and 38, 40, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al. (US 5,629,980 A).

Claims 7, 30, and 36:

Stefik discloses the digital works usage rights and permissions system as shown in the rejections above. Stefik does not disclose playback means as a personal video or versatile recorder. However, the Examiner takes **Official Notice** that such devices are common and well-known to the digital works community because they are user-friendly and easily obtainable devices for rendering digital works.

Claim 14:

Stefik discloses the digital works usage rights and permissions system as shown in the rejections above. Stefik does not disclose a wireless network. However, the Examiner takes **Official Notice** that such wireless networks are common and well-known to the computer and telecommunication arts because wireless networks supply seamless communication between servers, Internet service providers, and end-user electronics, thereby providing seamless mobile communications for traveling users.

Claims 32 and 38:

Stefik discloses the digital works usage rights and permissions system as shown in the rejections above. Stefik does not disclose SSL connections. However, the Examiner takes **Official Notice** that SSL network connections are common and well-known to the computer and telecommunication arts because it provides secure networks communications between servers, Internet service providers, and end-user electronics, thereby making available protected mobile communications for traveling users.

Claims 40 and 41:

Stefik discloses the digital works usage rights and permissions system as shown in the rejections above. Stefik does not disclose:

- *a set-top terminal and said first network comprises a cable network;*
- *a device that both stores and reproduces said content;*

However, the Examiner takes **Official Notice** that cable boxes, digital video recorders, and digital video/audio players are common and well-known to the computer and telecommunication arts because they provide user-friendly access to digital content through the cable networks.

Conclusion

12. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
13. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **James A. Reagan** whose telephone number is **571.272.6710**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **571.272.6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

703.305.7687 [Official communications, After Final communications labeled "Box AF"]

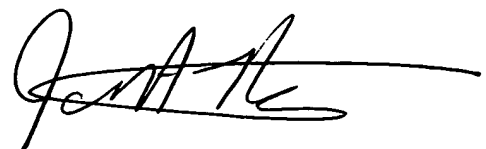
703.308.1396 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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JAR

03 May 2005

A handwritten signature in black ink, appearing to read 'James A. Reagan', with a long horizontal flourish extending to the right.